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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/056,021 | 01/28/2002 | Massimo Bechis | 08719-0207 | 2211 |

7590 07/29/2004
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

MAYO III, WILLIAM H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2831

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Notice of Allowability

Application No.

10/056,021

Examiner

William H. Mayo III

Applicant(s)

BECHIS ET AL.

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to March 29, 2004.
2. ☒ The allowed claim(s) is/are 21,23-35 and 37-41.
3. ☒ The drawings filed on 28 January 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date <u>May 28, 2003</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

William H. Mayo III
Primary Examiner
Art Unit: 2831

DETAILED ACTION

Allowable Subject Matter

1. Claims 21, 23-35, and 37-41 are allowed.
2. The following is an examiner's statement of reasons for allowance: This invention deals with a system comprising a storage unit wherein said storage unit has a predetermined volume adapted to contain a quantity of said third refrigeration fluid at said predetermined temperature corresponding to the thermal consumption of said superconducting cable for at least two hours in the absence of heat exchange with said second refrigerating fluid (claims 21 & 35). This invention deals with a method of cooling a superconducting cable wherein said cryogenic bath has a predetermined volume adapted to contain a quantity of said third refrigeration fluid at said predetermined temperature corresponding to the thermal consumption of said superconducting cable for at least two hours in the absence of heat exchange with said second refrigerating fluid (claim 40).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

3. Applicant's arguments filed March 29, 2004 have been fully considered and they are persuasive. Specifically, the applicant argument that there is nothing in the entirety of Graneau to teach or suggest to a person of ordinary skill in the art that Graneau's tank 25 has a volume "adapted to contain a quantity of said third refrigerating fluid corresponding to the thermal consumption of said superconducting cable for at least two hours in the absence of a heat exchange with said second refrigerating fluid" and therefore "there is simply no recognition of all of these conditions to make that calculation, therefore Graneau fails to expressly disclose or teach every element of the claimed invention, and the Examiner cannot rely on Graneau as an anticipating reference under 35 U.S.C. 102", is persuasive and therefore the claims have been allowed.

Communication

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WHM III
May 12, 2004

William H. Mayo III
Primary Examiner
Art Unit 2831